

REMARKS/ARGUMENTS

In this Second Amendment After Final Under 37 C.F.R. § 1.116 (“Second AAF”), Applicants propose to amend claim 2 to recite, inter alia, “wherein the multiple modulus selector is used in the public-key cryptographic algorithm”; amend claim 12 to recite, inter alia, “wherein the Montgomery modular multiplier is used in the public-key cryptographic algorithm”; and amend claim 17 to recite, inter alia, “wherein the Booth recoder is used in the public-key cryptographic algorithm”; all in order to better define the claimed invention. No new matter is introduced.

Prior to entry of the Second AAF, claims 2-15 and 17¹ were pending in the application. After entry of the Second AAF, claims 2-15 and 17 remain pending in the application.

In the Final Office Action (“FOA”), the Examiner rejected claims 2-17 under 35 U.S.C. § 101; and rejected claim 16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,206,827 to Tsuruta (“Tsuruta”).

Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 101.

¹ Applicants filed an Amendment After Final Under 37 C.F.R. § 1.116 (“First AAF”) on November 12, 2008. Based at least in part on the enclosed cover page of the First AAF printed from the USPTO web site—stating “OK TO ENTER: /C.N./ 11/21/08”—and the Advisory Action mailed on November 26, 2008, Applicants understand that the First AAF has been entered by the USPTO. Thus, Applicants understand that claim 16 has been canceled.

Entry of Second Amendment After Final

Applicants submit that the proposed amendments to claims 2, 12, and 17 do not raise new issues that would require further consideration and/or search, and does not raise the issue of new matter. Additionally, Applicants submit that the proposed amendments to claims 2, 12, and 17 place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Therefore, Applicants submit that this Second AAF should be entered and considered by the Examiner.

Incorporation of Previous Arguments by Reference

In addition to the arguments presented below, Applicants specifically incorporate by reference the arguments made in the Amendment Under 37 C.F.R. § 1.111 ("First Amend") filed on June 11, 2008, and in the First AAF.

Interview Summary

On January 6, 2009, Examiner Ngo and Applicant's representative (Lawrence F. Galvin, Reg. No. 44,694) conducted a telephone interview. During the interview, Examiner Ngo and Applicant's Representative discussed independent claims 2, 12, and 17 and the rejection under 35 U.S.C. § 101. The amendments to independent claims 2, 12, and 17 shown under the heading "Amendments to the Claims" above were discussed and it was agreed that these amendments would overcome the rejection of claims 2-15 and 17 under 35 U.S.C. § 101.

Claim Rejection Under 35 U.S.C. § 102(b)

As discussed in footnote 1, Applicants understand that claim 16 has been canceled by entry of the First AAF. Applicants submit that this cancellation already obviated the rejection under 35 U.S.C. § 102(b).

Claim Rejection Under 35 U.S.C. § 101

Applicants submit that claims 2-15 and 17 are directed to statutory subject matter under 35 U.S.C. § 101 for at least the following reasons.

First, Applicants submit that agreement was reached between the Examiner and Applicant's Representative during the interview held on January 6, 2009—the agreement being that the amendments to independent claims 2, 12, and 17 shown under the heading “Amendments to the Claims” above would overcome the rejection of claims 2-15 and 17 under 35 U.S.C. § 101.

Second, the United States Court of Appeals for the Federal Circuit recently released its en banc decision in In re Bilski. And that decision² appears to overrule at least the “useful, concrete and tangible result” analysis of State St. Bank & Trust Co. v. Signature Fin. Group, 47 USPQ2d 1596 (Fed. Cir. 1998) and AT&T Corp. v. Excel Communications, Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Thus, the In re Bilski decision completely undermines the FOA's analysis—which is based on the “useful, concrete and tangible result” test of the State Street decision.

² In re Bilski, No. 2007-1130, slip op. at 20 (Fed. Cir. Oct. 30, 2008).

Third, the FOA does not allege that any of claims 2-15 and 17 fall outside of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 (process, machine, manufacture, or composition of matter).

Fourth, the FOA does not appear to allege that any of claims 2-15 and 17 fall within any of the three judicial exceptions to patentable subject matter (abstract ideas, natural phenomena, and laws of nature)—at least because the FOA does not appear to mention “judicial exception”, “abstract idea”, “natural phenomenon”, or “law of nature”, even though the FOA discusses the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” dated November 22, 2005 (“Interim Guidelines”).

Fifth, the FOA is logically inconsistent, at least because it alleges that “the claimed inventions fail to accomplish a practical application” in one sentence, but alleges that “the claims appear to cover every substantial practical application” in the very next sentence. FOA, p. 2, § 2.

Sixth, as discussed above, the FOA alleges that “the claims appear to cover every substantial practical application”. Id. However, the FOA does not “identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical applications thereof”, as required by Section IV.C.3 of the Interim Guidelines.

Seventh, as discussed above, the FOA alleges that “the claims appear to cover every substantial practical application”. Id. However, each of claims 2-15 and 17 is directed to a multiple modulus selector (or Montgomery

modular multiplier or Booth recoder) of a computer system, communication network, or computer system and communication network. Further, each of claims 2-15 and 17 is directed to a multiple modulus selector (or Montgomery modular multiplier or Booth recoder) of a computer system, communication network, or computer system and communication network that uses a public-key cryptographic algorithm, wherein the multiple modulus selector (or Montgomery modular multiplier or Booth recoder) is used in the public-key cryptographic algorithm. Thus, for example, any computer system, communication network, or computer system and communication network that does not use a public-key cryptographic algorithm also does not fall within the literal scope of claims 2-15 and 17. For at least these reasons, Applicants submit that claims 2-15 and 17 do not cover every substantial practical application. And, as a result, Applicants submit that claims 2-15 and 17 cannot preempt a judicial exception under 35 U.S.C. § 101.

For all of these reasons, Applicants submit that claims 2-15 and 17 are directed to statutory subject matter under 35 U.S.C. § 101, and request that the associated rejection be withdrawn.

Request for Reconsideration and Allowance

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of each of claims 2-15 and 17 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Director of the USPTO is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; in particular, extension of time fees.

Respectfully submitted,

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By _____

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